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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,829	08/07/2001	Thilo Gabler	46894/FLC/W391	1850

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EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/18/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,829

Applicant(s)

GABLER, THILO

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is in response to a letter for patent filed on August 7th, 2001 in which claims 1-12 are presented for examination. Claims 1-12 are pending in the letter.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case the inventive concept in claim 1-6 only recites an abstract idea. The recited of receiving a user profile, selecting advertisement... etc. does not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by

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use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma (CCPA 197 USPQ 852 (1978))*.

Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-6 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grace (U.S. Patent No. 5,991,735 (*Applicant admitted prior art*)) in view of Ilan et al (U.S. PG Pub. No. 2003/0171096).

5. As per claims 1 and 7, Grace teaches a system and method for incentive advertising, comprising a processor; and a memory operably coupled to the processor and having program instructions stored therein, the processor being operable to execute the program instructions, the program instructions including: receiving a viewer profile, the viewer profile including a viewer identification; selecting advertising content based on the viewer profile; sending the advertisement content for display to a viewer (*see abstract, column 2 line 10-3 line 46*). Grace fails to teach an inventive concept of recording a viewer response to the advertising content and

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the viewer identification for awarding an advertising incentive. However, Ilan et al teach an inventive concept of recording a viewer response to the advertising content and the viewer identification for awarding an advertising incentive (*see paragraphs 0011, 0040, 0074, 0075*). Therefore, it would have been obvious to one of ordinary skill in that at the time the invention was made to modify the inventive concept of Grace to include Ilan et al's inventive concept of recording a viewer response to the advertising content and the viewer identification for awarding an advertising incentive because this would have encourage user to view the selected advertisement.

6. As per claims 2 and 8, Grace teaches a system and method wherein the advertising incentive is an entry into a game of chance (*see abstract, column 2 line 10-3 line 46*).

7. As per claims 3 and 9, Grace teaches a system and method wherein the viewer response is a single value indicating the viewer's preference for the advertising content (*see abstract, column 2 line 10-3 line 46*).

8. As per claims 4 and 10, Grace teaches a system and method wherein the viewer response is the viewer's answer to an advertiser's question (*see abstract, column 2 line 10-3 line 46*).

9. As per claims 5 and 11, Grace teaches a system and method wherein the advertiser's question is customized by the advertiser to accompany the advertising content (*see abstract, column 2 line 10-3 line 46*).

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10. As per claims 6 and 12, Grace teaches a system and method further comprising: receiving a first viewer's comments about a brand; generating a chat broadcast message from the first viewer's comments; transmitting the chat broadcast message to a plurality of viewers (*see abstract, column 2 line 10-3 line 46*).

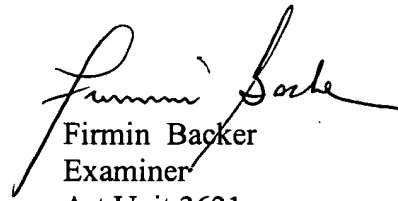
Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Firmin Backer
Examiner
Art Unit 3621

December 8, 2003